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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,868	11/16/2000	James Tuchler	28474/36530	4785
23409	7590	10/12/2004	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER

3624

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/713,868

Applicant(s)

TUCLER ET AL.

Examiner

JAGDISH PATEL

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*NY*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-27 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. This communication is in response to amendment filed 7/14/04.

***Response to Amendment***

2. Amended claims 1, 13, 24 and 27 are entered.

***Response to Arguments***

3. Applicant's arguments with respect to pending claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1, 11, 12, 13, 22,23 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Maclin et al.(US

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Publication No. 2002/0032662, filed September 4, 2001, priority August 30, 2000) (Maclin).

Per claim 1, Maclin teaches a method for allowing a customer at an online Internet client device to make Internet purchases using a temporary credit card number (abstract and Fig. 1), the method comprising:

during an Internet purchase transaction receiving a message indicative of a request to apply for a credit card account at an Internet server from the Internet client device via the Internet (para [0008] and [0021] and [0044]);

during the Internet purchase transaction transmitting data indicative of an electronic credit card account application from the Internet server to the Internet client device via the Internet ( para [0021] ..receiving a customer package of variables.);

during the Internet purchase transaction receiving the credit card account application at the Internet server from the client device via the Internet, the credit card account application including applicant data (see step 424 of Fig. 5, see also para [0028-0029]);

during the Internet purchase storing the applicant data in a computer readable memory (see [0032]);

during the Internet purchase verifying the applicant data against a verification database (see step 426 of Fig. 5, see also [0055]) ;

during the Internet purchase if the applicant data is verified, opening the credit card account and issuing a temporary credit card number..unique among a plurality of currently active temporary card numbers (see steps 426-430 of Fig. 5), the temporary credit card number available for immediate use, after

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opening the credit card account, as payment in the Internet purchase transaction (see Fig. 5 and relevant detailed description).

allowing a plurality of Internet based purchases based on the temporary credit card number until the temporary credit card number is deactivated (see steps 436, note that the transaction may include a plurality of purchases and the temporary credit card number is valid for the purchase transaction only, suggesting that the card is deactivated or invalidated after the current e-commerce transaction) ; and

deactivating the temporary credit card number (para ([0032] this step is inherent because the temporary credit card number is generated that is only valid for a specific transaction).

Claim 11: issuing a traditional card in the name of the customer based on the applicant data, the traditional card associated with a traditional card number, the traditional card number being different than the temporary credit card number (see Fig. 9 validating secure e-commerce transaction and para [0045]).

Claim 12: transferring a balance associated with the temporary credit card number to an account associated with the traditional credit card number (para [0057]).

All elements of the apparatus of claim 13 are shown in Figure 1. Network components are part of computer network(s) 106, microprocessor is indicated as E-commerce server, which comprises program to carry out method steps as explained in the method claim that corresponds to claim 13.

Claims 22 and 23 have been analyzed according to respective method claims 11 and 12.

All limitations of claim 27 have been analyzed in claim 1 and claims 13.

***Claim Rejections - 35 USC § 103***

6. Claims 2, 4, 5, 8, 10, 14, 16, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maclin as applied to claim 1 and further in view of Flitcroft.

Claims 2: Maclin fails to teach, however, Flitcroft in the same field of endeavor teaches deactivating the temporary card number comprises, expiring the temporary credit card number in response to a predetermined time period elapsing (see "limited use" and "deactivated").

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the feature of deactivating the temporary card number including expiring the credit card number in response to a predetermined time period elapsing in order to reduce possibility of the credit card number being monitored or stolen for unauthorized use.

Claim 4 and 5: Maclin fails to teach, however, Flitcroft in the same field of endeavor teaches deactivating the temporary credit card number in response to receiving a request for a predetermined web page from the Internet client device (para [0052] the limits that can be placed on the use the single use credit number or multi-use credit card number ..are almost limitless..the use of the credit card number could be limited by ..merchant..(note this implies requesting a specific merchant's web page in context of the Flitcroft method as shown in Fig. 1)).

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It would have been obvious to one of ordinary skill in the art at the time of invention to implement the feature of deactivating the temporary credit card number in response to receiving a request for a predetermined web page from the Internet client device because this would prevent use of the card only to the merchant with whom the current Internet transaction is carried out.

Claim 8: Maclin fails to teach, however, Flitcroft in the same field of endeavor teaches deactivating the temporary credit card number in response to a predetermined dollar amount of purchases being made using the temporary credit card number (para [0052] the limits that can be placed on the use the single use credit number or multi-use credit card number ..are almost limitless..the use of the credit card number could be limited by..amount).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the feature of deactivating the temporary credit card number in response to predetermined dollar amount of purchases being made using the temporary credit card number because this would limit the unauthorized use to a predefined dollar amount thereby protecting the card owner.

claim 10: Maclin fails to teach, however, Flitcroft in the same field of endeavor teaches deactivating the temporary credit card number in response to a predetermined number of purchase transactions..(para [0056] "...when the aggregate amount of a series of transactions exceeded a specific credit limit that the

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credit card number would be canceled", note that the predetermined number is defined by the aggregate amount of the transactions, alternatively para [0055] discloses that the temporary credit card number is deactivated after a single use which the predetermined number of transactions). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the feature of deactivating the temporary credit card number in response to predetermined number of purchase transactions being made using the temporary credit card number because this would limit the unauthorized use to a predefined dollar amount thereby protecting the card owner.

Apparatus claims 14, 16, 17, and 20 correspond to respective method claims 2, 4, 5, 8, 10.

11. Claims 2, 4, 5, 8, 10, 14, 16, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maclin as applied to claim 1 and further in view of Demoff.

Claim 24: Maclin teaches limitations network receiver (see Fig. 1 and discussion of claim 13), a verification module, a verification database (see [0054]), a temporary account module (see [0055 and 0056]), purchase approval module (see [0057]). Maclin, however fails to teach a temporary account database in communication with the temporary account module as per claim 24. This is because Maclin generates the temporary account by applying random numbers to the six digits of the customer's traditional credit card number (see [0056]).



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However, in the same field of endeavor, Demoff teaches an apparatus for allowing a customer at an Internet client device to make Internet based purchases using a temporary credit card number, the apparatus comprising:

a temporary account database in communication with the temporary account module (para [0025] subsystem 28 accesses database 28);

the temporary account module being structured to query the temporary account database to issue a temporary credit card number if the applicant data is verified, the temporary credit card number being unique.. (para [0025] refer to unique ID);

It would have been obvious to one of ordinary skill in the art at the time of invention to one of ordinary skill in the art to incorporate a temporary account to modify the structure of the temporary account module and by adding a temporary account database in communication with the account module such that the temporary account number is generated based on the query from the temporary account module as a preference of the system designer to obtain the same result as the claimed invention which is issue a temporary credit card number.

Claim 25: network transmitter being structured to transmit the temporary credit card number (see Fig. 1 of Maclin).

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Claim 26: Maclin fails to teach, however, Demoff teaches a deactivation module being structured to deactivate the temporary credit card number in response to occurrence of a predefined condition (para [0030] ..period of authorization for generated credit transaction number..such as one minute).

It would have been obvious to one of ordinary skill in the art at the time of invention to one of ordinary skill in the art to incorporate to incorporate a deactivation module as per claim because deactivating the temporary credit card number under certain conditions such as excess time elapsing without any activity would protect the card owner against unauthorized charges.

#### ***Allowable Subject Matter***

13. Claims 3,6,7,9,15,18,19,21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. It is interpreted that expiring the credit card number amounts to the credit card number rendered unusable for any purchase transaction.

#### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is

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reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

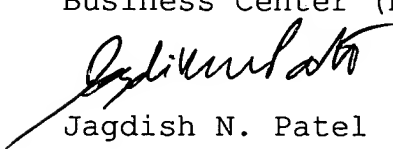
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703) 308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

10/6/04